



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/410,818	10/01/1999	JAY S. WALKER	99-034	7518
22927	7590	02/17/2004	EXAMINER	
WALKER DIGITAL FIVE HIGH RIDGE PARK STAMFORD, CT 06905			DURAN, ARTHUR D	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 02/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/410,818

Applicant(s)

WALKER ET AL

Examiner

Arthur Duran

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-49, 51-57 and 63-71 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-49, 51-57 and 63-71 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-4, 6-49, 51-57, and 63-71 have been examined.

Response to Amendment

2. The Amendment filed on 2/2/2004 has been considered and is insufficient to overcome the Keithley, Ferguson, and Odom reference.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-4, 6-49, 51-55, 63-67, and 71 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. These claims are rejected under 35 U.S.C. 101 because these claims have no connection to the technological arts. The method claims do not specify how the claims utilize any technological arts. For example, no network or server is specified. To overcome this rejection, the Examiner recommends that the Applicant amend the claim to specify or to better clarify that the method is utilizing a medium or apparatus, etc within the technological arts. Appropriate correction is required.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to

Art Unit: 3622

"[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673

Art Unit: 3622

(1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*.

Art Unit: 3622

However, State Street never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

In the current application, no technological art (i.e., computer, network, server) is being utilized by claims 1-4, 6-49, 51-55, 63-67, and 71. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-4, 6-49, 51-57, and 63-71 are rejected under 35 USC § 103(a) as being unpatentable over Keithley (5,584,025) in view of Ferguson (5,819,092) and in further view of Odom (6,058,379).

Claim 1: Keithley discloses an apparatus and method for interactive communication for tracking and viewing data. Keithley further discloses that home information can be transmitted to a viewer (col 4, lines 10-13).

Keithley does not explicitly disclose that the information provider (homeowner) is compensated for providing their information.

However, Ferguson discloses an online service development tool with fee setting capabilities. Ferguson further discloses that a content provider can be paid for providing information (col 3, lines 50-55) based on a modifiable system (col 4, lines 60-62).

Ferguson further discloses that Applicant's invention can be utilized for the selling of goods or services (col 3, lines 30-40), that the content provider can be paid for providing useful information of a wide variety (col 3, lines 50-55), that the content provider or the purchaser can each be paid or charge for information providing or information access depending on the embodiment of the invention (col 9, lines 3-7), that the content can be informational or that the content can be purchased or the content can lead to a purchase (col 8, line 60-col 9, line 10), that the content can be provided for informational purposes or for purposes of leading to a purchase (col 13, lines 47-55; col 15, lines 44-48).

Therefore, it would have been obvious to one of ordinary skill in the art to add Ferguson's compensating the information provider method to Keithley's method for tracking and viewing home data. One would have been motivated to do this so that Keithley has a way to motivate content providers, that may or may not be interested in selling, to provide their information.

While Keithley and Ferguson do disclose all the above, Keithley does not explicitly disclose that the homeowner can display properties that are currently not marketed for sale. Additionally, Keithley nor Ferguson discloses determining a rating of the homeowner's

Art Unit: 3622

willingness to sell the home and allowing the viewer to communicate with the homeowner if the rating is at least equal to the predetermined rating.

However, Odom discloses real-time network exchange with seller specified exchange parameters and interactive seller participation. Odom further discloses that any commodity, good, service, or item can be displayed (col 5, lines 25-30), that seller anonymity can be maintained (col 12, lines 38-45), that a threshold can be set up by the seller such that offers that do not meet the seller established criteria are never sent to the seller (col 6, lines 45-55; col 6, lines 37-45), that the seller does not need to sell the item (col 8, lines 25-27), that the seller can determine multiple aspects and criteria of item display, information exchange, or selling conditions (col 2, lines 34-39; col 2, lines 43-49; col 3, lines 15-21; col 3, lines 34-37; col 3, lines 55-61), that purchasers can 'chat' with sellers at the sellers discretion and if they meet seller established criteria (col 6, lines 12-20; col 4, lines 50-55; col 5, lines 34-38).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Odom's seller specified exchange criteria to Keithley's method for tracking and viewing home data. One would have been motivated to do this because giving the seller further control of the conditions under which homes are displayed will further entice homeowners to display their homes.

Furthermore, Odom analyzes the seller provided information to determine ratings of thresholds for criteria in different categories or goal that represents when the seller will sell or not. Odom is attempting to identify the threshold where the seller will sell or not. Hence, Odom is determining a rating of the seller's willingness to sell. Because Odom is presenting best bids considered of interest to the seller's goals, Odom is presenting information based upon a rating

Art Unit: 3622

of the seller's willingness to sell. Odom must determine what the seller's willingness to sell is for the different goals or categories in order to present the seller with the best bid in interest of the seller's goals (col 6, lines 45-55; col 14, lines 26-32).

Claim 2: Keithley and Ferguson disclose a method as in claim 1 above. Keithley further discloses how an Agent may obtain property listing information from a property owner (col 10, lines 52-58).

Claim 3: Keithley and Ferguson disclose a method as in claim 1 above. Keithley does not explicitly disclose periodic compensation.

However, Ferguson discloses that content providers can be paid based on a customizable payment system (col 4, lines 60-63).

Ferguson further discloses an online service development tool with fee setting capabilities. Ferguson further discloses that a content provider can be paid for providing information (col 3, lines 50-55) based on a modifiable system (col 4, lines 60-62).

Ferguson further discloses that Applicant's intention can be utilized for the selling of goods or services (col 3, lines 30-40), that the content provider can be paid for providing useful information of a wide variety (col 3, lines 50-55), that the content provider or the purchaser can each be paid or charge for information providing or information access depending on the embodiment of the invention (col 9, lines 3-7), that the content can be informational or that the content can be purchased or the content can lead to a purchase (col 8, line 60-col 9, line 10), that the content can be provided for informational purposes or for purposes of leading to a purchase (col 13, lines 47-55; col 15, lines 44-48).

Therefore, it would have been obvious to one of ordinary skill in the art to add Ferguson's flexibly compensating the information provider method to Keithley's method for tracking and viewing home data. One would have been motivated to do this so that Keithley has a way to motivate content providers, that may or may not be interested in selling, to provide their information.

Claims 4, 20, 21, 22, and 23: Keithley and Ferguson disclose a method as in claim 1 above. Keithley further discloses that a digitized picture (col 13, lines 12-15), video, and graphics (col 9, lines 5-9) of the property are provided.

Claim 5: Keithley and Ferguson disclose a method as in claim 1 above. Keithley further discloses that a user may view real estate that need not be for sale but for fostering related ideas of all kinds (col 10, lines 4-12 and col 7 lines 20-23). Keithley does not explicitly state that the real estate is not for sale. However, Ferguson discloses that the content provider can provide valuable informational content (col 4, lines 60-67). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Ferguson's information alone content to Keithley's data tracking and viewing method. One would have been motivated to do this so that Keithley's content providers are not obligated to sell as Ferguson discloses.

Claims 6, 7, 17, 18, and 19: Keithley and Ferguson disclose a method as in claim 1 above. Keithley further discloses that the owner information and home address need not be provided to the user (col 8, lines 20-25).

Claims 8, 10, and 13-16: Keithley and Ferguson disclose a method as in claim 1 above. Keithley further discloses that the method tracks the number of viewers (col 7, lines 17-23), the

Art Unit: 3622

popularity of a locale (col 10, lines 30-35), the level of interest in a home (col 7, lines 20-23 and col 11, lines 16-18), and quality of features (profile) of a property (col 9, line 61-col 10, line 1), and the price information (Fig. 9, Price).

Claims 9 and 12: Keithley and Ferguson disclose a method as in claim 1 above. Keithley further discloses that a line of credit or special loan can be awarded based on information tracked by the system (col 11, lines 47-53).

Claim 11: Keithley and Ferguson disclose a method as in claim 1 above. Keithley does not explicitly disclose a fixed, predetermined compensation.

However, Ferguson discloses that content providers can be paid on a for-fee basis (predetermined amount) (col 3, lines 52-53).

Ferguson further discloses an online service development tool with fee setting capabilities. Ferguson further discloses that a content provider can be paid for providing information (col 3, lines 50-55) based on a modifiable system (col 4, lines 60-62).

Ferguson further discloses that Applicant's invention can be utilized for the selling of goods or services (col 3, lines 30-40), that the content provider can be paid for providing useful information of a wide variety (col 3, lines 50-55), that the content provider or the purchaser can each be paid or charge for information providing or information access depending on the embodiment of the invention (col 9, lines 3-7), that the content can be informational or that the content can be purchased or the content can lead to a purchase (col 8, line 60-col 9, line 10), that the content can be provided for informational purposes or for purposes of leading to a purchase (col 13, lines 47-55; col 15, lines 44-48).

Art Unit: 3622

Therefore, it would have been obvious to one of ordinary skill in the art to add Ferguson's flexibly compensating the information provider method to Keithley's method for tracking and viewing home data. One would have been motivated to do this so that Keithley has a way to motivate content providers, that may or may not be interested in selling, to provide their information.

Claims 24 and 25: Keithley and Ferguson disclose a method as in claim 1 above. Keithley further discloses that the viewer may be charged a fee for viewing home information (col 12, line 66- col 13, line 3).

Claim 26: Keithley and Ferguson disclose a method as in claim 24 above. Keithley further discloses that the viewer can be charged a fee for viewing home information (col 12, line 66- col 13, line 3).

Claims 27, 29-32, 34-39: Keithley and Ferguson disclose a method as in claims 24, 23, and 60 above. Keithley further discloses that the invention provides detailed data on all aspects of viewership and response, keeping track of this information via access codes (col 1, lines 34-45), and that a viewer can be charge a fee based on usage of the service and the access codes (col 12, line 64-col 13, line 3).

Claim 28: Keithley and Ferguson disclose a method as in claims 24 above. Keithley further discloses that the invention provides detailed data on all aspects of viewership and response, keeping track of this information via access codes (col 1, lines 34-45), and that a viewer can be charge a fee based on usage of the service and the access codes (col 12, line 64-col 13, line 3).

Keithley does not explicitly state that the fee can be based on at least one of the appraised value of the home, the potential selling price of the home, and the difference between the appraised value and the potential selling price.

However, Ferguson discloses a complex fee setting tool based on multiple attributes (col 4, lines 30-32), that the fee setting tool can set the compensation level for content providers for valuable information (col 4, lines 60-67), and that the viewer can be charge for the information based on the complex fee setting tool scripting (col 4, lines 30-32, col 4, lines 60-67).

Therefore, it would have been obvious to one of ordinary skill in the art to add Ferguson's complex fee setting to Keithley's charging the viewer for viewing data. One would have been motivated to do this so that Keithley has a way to charge for the level of content provided as Ferguson discloses.

Claim 33: Keithley and Ferguson disclose a method as in claims 24 above. Keithley further discloses that the invention provides detailed data on all aspects of viewership and response, keeping track of this information via access codes (col 1, lines 34-45), and that a viewer can be charge a fee based on usage of the service and the access codes (col 12, line 64-col 13, line 3). Keithley further discloses that demographic information on the viewer be collected (col 14, lines 58-65).

Claims 40-44: Keithley and Ferguson disclose a method as in claim 1 above. Keithley further discloses that viewer information, viewer home preferences (col 13, lines 31-40), and viewer interest in a home can be received (col 7, lines 20-23). Keithley further discloses that based on this information a set of home information can be sent to the user (col 13, lines 37-40) and the homes can be for sale (col 13, lines 44-45).

Claims 45-46, and 54: Keithley and Ferguson disclose a method as in claim 1 above, claim 53 below, and claim 58 below. Keithley further discloses that the user can shop for homes on the service and that there are databases for receiving the purchase information (col 10, lines 4-5 and col 10, lines 58-62). Keithley further discloses that the owner is notified of the offer (col 10, lines 64-67).

Claims 47 and 55: Keithley and Ferguson disclose a method as in claims 45 and 54 above. Keithley further discloses that the end user need not provide their information (col 7, lines 20-23).

Claim 48: Keithley and Ferguson disclose a method as in claim 45 above. Keithley further discloses that the end user enters their purchase price (col 13, lines 31-33).

Claim 49: Keithley and Ferguson disclose a method as in claim 45 above. Keithley further discloses that owner information is stored in the property profiles database (col 6, lines 30-32) and that transactions information is stored in a transactions database (col 10, lines 58-63). While Keithley does not explicitly state that the owner can be penalized for not selling, Keithley infers that the Agent could take such actions utilizing the information in these databases.

Claim 51: Keithley and Ferguson disclose a method as in claim 1 above. Keithley further discloses that a home picture can be displayed (col 13, lines 12-15) and that the homeowner can remain anonymous (col 8, lines 20-25). Keithley, therefore, infers that owner identifying information can be taken out of the picture.

Claims 52-53, 56-57, 63-64, 66-67, and 69-71: Keithley discloses an apparatus and method for interactive communication for tracking and viewing data. Keithley further discloses that home information can be transmitted to a viewer using a remote viewing device (col 4, lines

Art Unit: 3622

10-13). Keithley further discloses that a picture of the home can be made available (col 13, lines 12-15). Keithley further discloses that the homeowner can remain anonymous (col 8, lines 20-25) and that the viewer can be charged (col 12, line 66-col 13, line 3). Keithley further discloses that an Agent obtains property listing information from an owner for sale (col 10, lines 52-58). Keithley further discloses that the user can indicate their interest in a home (col 7, lines 20-23). Keithley further discloses the user providing an offer to purchase the home (col 13, lines 30-53).

Keithley does not explicitly disclose that the information provider (homeowner) is compensated for providing their information.

However, Ferguson discloses an online service development tool with fee setting capabilities. Ferguson further discloses that a content provider can be paid for providing information (col 3, lines 50-55) based on a modifiable system (col 4, lines 60-62).

Ferguson further discloses that Applicant's invention can be utilized for the selling of goods or services (col 3, lines 30-40), that the content provider can be paid for providing useful information of a wide variety (col 3, lines 50-55), that the content provider or the purchaser can each be paid or charge for information providing or information access depending on the embodiment of the invention (col 9, lines 3-7), that the content can be informational or that the content can be purchased or the content can lead to a purchase (col 8, line 60-col 9, line 10), that the content can be provided for informational purposes or for purposes of leading to a purchase (col 13, lines 47-55; col 15, lines 44-48).

Therefore, it would have been obvious to one of ordinary skill in the art to add Ferguson's compensating the information provider method to Keithley's method for tracking and viewing home data. One would have been motivated to do this so that Keithley has a way to

Art Unit: 3622

motivate content providers, that may or may not be interested in selling, to provide their information.

While Keithley and Ferguson do disclose all the above, Keithley does not explicitly disclose that the homeowner can display properties that are currently not marketed for sale. Additionally, Keithley nor Ferguson discloses determining a rating of the homeowner's willingness to sell the home and allowing the viewer to communicate with the homeowner if the rating is at least equal to the predetermined rating.

However, Odom discloses real-time network exchange with seller specified exchange parameters and interactive seller participation. Odom further discloses that any commodity, good, service, or item can be displayed (col 5, lines 25-30), that seller anonymity can be maintained (col 12, lines 38-45), that a threshold can be set up by the seller such that offers that do not meet the seller established criteria are never sent to the seller (col 6, lines 45-55; col 6, lines 37-45), that the seller does not need to sell the item (col 8, lines 25-27), that the seller can determine many aspects and criteria of item display, information exchange, and selling conditions (col 2, lines 34-39; col 2, lines 43-49; col 3, lines 15-21; col 3, lines 34-37; col 3, lines 55-61), that purchasers can 'chat' with sellers at the sellers discretion and if they meet seller established criteria (col 6, lines 12-20; col 4, lines 50-55; col 5, lines 34-38).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Odom's seller specified exchange criteria to Keithley's method for tracking and viewing home data. One would have been motivated to do this because giving the seller further control of the conditions under which homes are displayed will further entice homeowners to display their homes.

Furthermore, Odom analyzes the seller provided information to determine ratings of thresholds for criteria in different categories or goal that represents when the seller will sell or not. Odom is attempting to identify the threshold where the seller will sell or not. Hence, Odom is determining a rating of the seller's willingness to sell. Because Odom is presenting best bids considered of interest to the seller's goals, Odom is presenting information based upon a rating of the seller's willingness to sell. Odom must determine what the seller's willingness to sell is for the different goals or categories in order to present the seller with the best bid in interest of the seller's goals (col 6, lines 45-55; col 14, lines 26-32).

Claim 65: Keithley and Ferguson disclose a method as in claim 64 above. Keithley further discloses that the user can shop for homes on the service and that there are databases for receiving the purchase information (col 10, lines 4-5 and col 10, lines 58-62) including the offer price made by the viewer (col 13, lines 31-33). Keithley further discloses that the owner is notified of the offer (col 10, lines 64-67) and that marketing data information can be used by the Agent to make notification decisions (col 10, lines 58-67).

Claim 68: Keithley and Ferguson disclose a method as in claim 1 above. Keithley further discloses that the compensation information includes one or more of an appraised value of home, a location of home, an expected interest of viewers in the home, a level of anonymity maintained with respect to the homeowner of the home, and a current market price of the home (col 7, lines 17-23; col 10, lines 30-35; col 7, lines 20-23; col 11, lines 16-18; col 9, line 61-col 10, line 1; Fig. 9, Price; and col 8, lines 20-25).

Response to Arguments

5. Applicant's arguments with respect to claims 1-4, 6-49, 51-57, and 63-71 have been considered but are not found persuasive.

Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety that is being referred to.

Examiner further notes that it is the Applicant's claims as stated in the Applicant's claims that are being rejected with the prior art.

Examiner notes that a USC 103(a) rejection was utilized. Thus, any single prior art was not deemed as having all the features of the Applicant's invention. Hence, the features of the prior art were combined.

In regards to Applicant's Arguments dated 2/2/04 concerning the 101 Technological Arts rejection of claims 1-4, 6-49, 51-55, 63-67, and 71, Examiner has stated and cited the current Office Policy concerning the interpretation of 35 USC 101 and the technological arts. Applicant must either amend the claims to correspond with 35 USC 101 as cited above or appeal to the patent board.

On page 17 of the Applicant's Amendment dated 2/2/04, Applicant states, "None of the prior art . . . teaches or suggests the following claim limitations: *determining a rating of the homeowner's willingness to sell his home*". Note that the Applicant's claims do not disclose who is performing the 'determining a rating of the homeowner's willingness to sell his home'. Hence, who performs the 'determining' is open to a broad interpretation.

Note that Odom discloses,

"In another embodiment of the invention, bids are not transmitted to the host if they are irrelevant. Irrelevant bids

Art Unit: 3622

may be bids that are less than the current "best" bid. In order to determine if the bid is relevant or not, the system determines what the seller's goal is (price, location, etc.) and then determines if the bid is more desirable to the seller than the current "best" bid. If it is, it replaces the "best" bid and the seller may be notified of the new highest bid. If it is not, the bid is disregarded. Notification may include a bid identifier, an amount and other information. (col 6, lines 45-55)",

and that,

"4. The method of claim 1 wherein said step of said seller identifying said commodity to be traded comprises:

said seller classifying said commodity;

said seller entering a price for said commodity; and,

said seller entering a goal for said exchange". (col 14, lines 26-32)

Odom analyzes the seller provided information to determine ratings of thresholds for criteria in different categories or goal that represents when the seller will sell or not. Odom is attempting to identify the threshold where the seller will sell or not. Hence, Odom is determining a rating of the seller's willingness to sell. Because Odom is presenting best bids considered of interest to the seller's goals, Odom is presenting information based upon a rating of the seller's willingness to sell. Odom must determine what the seller's willingness to sell is for the different goals or categories in order to present the seller with the best bid in interest of the seller's goals.

Additionally, the online Merriam-Webster dictionary found at www.m-w.com defines the verb "rate" as:

"1 *obsolete* : ALLOT

Art Unit: 3622

2 a : to set an estimate on : VALUE, ESTEEM <black is *rated* very high this season> **b** : to determine or assign the relative rank or class of : GRADE <*rate* a seaman> **c** : to estimate the normal capacity or power of

3 : CONSIDER, REGARD <was *rated* an excellent pianist>

4 : to fix the amount of premium to be charged per unit of insurance on

5 : to have a right to : DESERVE <she *rated* special privileges>

intransitive senses : to enjoy a status of special privilege <really *rates* with the boss>

, and the noun “rating” as:

“1 : a classification according to grade; *specifically* : a military or naval specialist classification

2 chiefly British : a naval enlisted man

3 a : relative estimate or evaluation : STANDING <the school has a good academic *rating*> **b** : an estimate of an individual's or business's credit and responsibility **c** : an estimate of the percentage of the public listening to or viewing a particular radio or television program

4 : a stated operating limit of a machine expressible in power units (as kilowatts of a direct-current generator) or in characteristics (as voltage)”

Utilizing definition 3 above, Odom discloses a relative estimate or evaluation of a seller's willingness to sell.

In regards to the combination of the Keithley, Ferguson, and Odom references, Applicant has presented new objections to these combinations in the Amendment dated 2/2/04 even though these same prior art references were utilized prior to the Amendment dated 7/3/03. The Amendment dated 7/3/03 did not object to the combination of the Keithley, Ferguson, and Odom references.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, Keithley concerns an information processing system for acquiring and displaying real estate industry related information (col 3, lines 30-33). Ferguson discloses an online marketing system with compensation for certain actions (Abstract). Odom discloses further features in terms of online marketing systems that involve seller and buyer relations (Abstract). Hence, Keithley would be motivated to utilize the features of Ferguson and Odom in order to allow for compensating parties involved in information exchange, thereby increasing utilization of the Keithley's real estate information system, and for allowing the system to be utilized for informational as well as directly sales related purposes, thereby expanding the range of utilization for Keithley's system.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (703)305-4687. The examiner can normally be reached on Mon- Fri, 7:30-4:00.

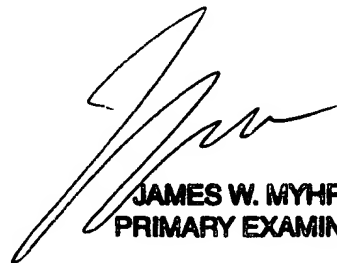
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703)305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3622

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AS

2/10/04


JAMES W. MYHRE
PRIMARY EXAMINER